

REMARKS

The Office Action mailed July 23, 2007, has been received and reviewed. Claims 1 – 11 are currently under consideration. Claims 1 – 11 stand rejected. The applicant submits the following remarks and respectfully submits that the claims are in condition for allowance without further searching by the Examiner.

Claim 1 has been amended to correct typographical errors and for consistency with the claim language of claim 2. No new matter has been added.

Claims 1, 2, 4-8, and 11 stand rejected as being unpatentable over Lampe in view of Ahn *et al.* (hereinafter “Ahn”) Applicant submits additional arguments herein as to the reasons why the combination of Lampe and Ahn fail to teach or suggest the claimed invention. Again, as the Examiner has stated on (page 4 of the Office Action), “Lampe does not teach that the mixture parts are equal, as required by claim 1.” The Examiner asserts that Ahn teaches an A-B mixture of silicone and catalyst, wherein part A is mixed equally with part B. See paragraph [0162].” Based upon a combination of Lampe with the purported teachings of Ahn, the Examiner concludes that claims 1, 2, 4-8 and 11 are unpatentable as being obvious under 35 U.S.C. 103(a).

When a patent claim is evaluated for patentability using a combination of references, the burden is on the examiner to establish a case of *prima facie* obviousness. *In re Fine* 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The test for establishing such a case is well stated in *In re Lintner*, 173 U.S.P.Q. 560, 562 (C.C.P.A. 1972) as follows:

In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teaching would appear to be sufficient for one of ordinary skill in the relevant art having the reference

before him to make the proposed substitution, combination or other modification.

Furthermore, the C.C.P.A. held in *In re Kuderna*, 165 U.S.P.Q. 575 (C.C.P.A. 1970):

We must approach the issue of patentability in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of the first one and then another of the isolated teachings in the art. . . . Where is the reason for one skilled in the art to so emphasize that one isolated teaching?

An excellent summary of how the prior art must be considered to make a case of *prima facie* obviousness is contained in *In re Ehrreich*, 200 U.S.P.Q. 504, 509-11 (C.C.P.A. 1979). There, the court stated that a reference must not be considered in a vacuum but against the background of the other references of record. It is stated that the question of a section 103 case is what the reference(s) would "collectively suggest" to one of ordinary skill in the art. However, the court specifically cautioned that the examiner must consider the entirety of the disclosure made by the reference and avoid combining them indiscriminately.

In finding that the "subject matter as a whole" would not have been obvious in *Ehrreich* the court concluded:

Thus, we are directed to no combination of prior art references which would have rendered the claimed subject matter as a whole obvious to one of ordinary skill in the art at the time the invention was made. The PTO has not shown the existence of all the claimed limitations in the prior art or a suggestion leading to their combination in the manner claimed by appellants.

It is often the case that, if one searches the art hard enough, each feature of a claimed invention may be found in some isolated teaching. However, that is not the point of "invention. It has been widely recognized that virtually every invention is a combination of elements and that most, if not all, of these will be found somewhere in an examination of the prior art. This reasoning led the

Federal Circuit, in *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 199 (Fed. Cir. 1983) to state:

The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.

To establish a *prima facie* case of obviousness with respect to a claimed composition, the prior art must provide some reason or motivation to make the claimed composition, *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (*en banc*). As more recently and aptly stated in *In re Jones*, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) (emphasis in original):

Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the . . . art would have been motivated to make the modifications of the prior art necessary to arrive at the claimed [invention].

With respect to properly considering the prior art, the C.C.P.A. stated in *In re Carroll*, 202 U.S.P.Q. 571, 572 (C.C.P.A. 1979), as follows:

One of the more difficult aspects of resolving questions of non-obviousness is the necessity 'to guard against slipping into use of hindsight.' *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 USPQ 459, 474 (1965). Many inventions may seem obvious to everyone after they have been made. However, 35 USC 103 instructs us to inquire into whether the claimed invention "would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Thus, in deciding the issue of obviousness, we must look at the prior art presented from a vantage point in time prior to when the invention was made, and through the eyes of a hypothetical person of ordinary skill in the art.

When making a rejection under 35 U.S.C. 103 there are three fundamental areas the Examiner is required, under 37 C.F.R. Section 1.106 and MPEP Section 706.02, to cover to fulfill the test enunciated in *Graham v. John Deere*, 383 U.S. 1, 148 U.S.P.Q. 454 (1966). First, the rejection should set forth the differences between the claims and the prior art. Second, the proposed

modification of the applied references necessary to arrive at the claimed subject matter should be set out. Third, there must be an explanation why such proposed modifications would be obvious.

Paragraph [0162] of Ahn states as follows:

[0162] Part A of silicone composition was prepared by combining 109.54 parts of Silicone Base, 0.032 part of Polymer A, and 0.43 part of Catalyst in a 4-oz. polypropylene cup. The components were mixed for three consecutive 12-second cycles using a Hauschild AM-501 dental mixer. Part B was prepared by combining 101.40 parts of Silicone Base, 0.073 parts of Polymer A, and 2.54 parts of Crosslinking Agent in a 4-oz. polypropylene cup and then mixing the components as described above for part A. Equal parts by weight of Part A and Part B were combined in a polystyrene weighing dish and mixed for about 30 s using a Teflon-coated spatula. The scrape adhesion of the cured silicone product is shown in Table 1.

According to Ahn, “[e]qual parts by weight of Part A and Part B were combined.” An examination of the compositions of Parts A and B, however, demonstrate that Ahn clearly fails to teach or suggest “mixing about equal parts of the silicone rubber base material and catalyst material to form a homogeneous putty” as recited in Claim 1 of the present application. As set forth in Ahn, Part A is formed of 109.54 parts of silicone base and 0.43 parts of catalyst. Thus, Part A of Ahn is a silicone base/catalyst mixture containing approximately 0.4% catalyst. Likewise, Part B of Ahn is 101.4 parts silicone base to 0.073 parts of Polymer A and 2.54 parts of crosslinking agent. Thus, Part B is over 97% silicone base. Combining Part A with Part B of Ahn results in a mixture that is over 98% silicone base. Nowhere does Ahn teach or suggest a mixture of “about equal parts of the silicone rubber base material and catalyst material to form a homogeneous putty.”

Based upon Ahn, the Examiner further asserts that “It would have been obvious to one of ordinary skill that the mixture parts of Lampe could be balanced equally in the manner of Ahn by

distributing the inert filler component.” Ahn, however, fails to teach such distribution of inert filler component as suggested by the Examiner and thus does not render the claims obvious. Indeed, the combination suggested by the Examiner would not result in the claimed invention. Ahn specifically teaches use of the silicone base in both of Parts A and B that would render the claimed invention unusable. That is, if the catalyst is already mixed with the silicone base, as set forth by Ahn, the curing process would begin before use and would render a product for forming ear and nose plugs in situ unusable. As such, the applicant respectfully submits that Ahn teaches away from the claimed invention and respectfully submits that the Examiner has failed to make a *prime facie* case of obviousness.

The applicant further incorporates its previous arguments with respect to the pending Office Action as if fully set forth herein. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

Should questions exist after consideration of the foregoing, the Examiner is kindly requested to contact the applicant’s attorney at the address or telephone number given herein.

Respectfully submitted,



Frank W. Compagni

Registration No. 40, 567

Attorney for Applicant

MORRIS O'BRYANT COMPAGN

734 South 200 East

Salt Lake City, Utah 84102

Telephone: (801) 478-0071

Facsimile: (801) 478-0076